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In re Application of :
Michael Schmidt et al :
Serial No.: 09/877,259 : PETITION DECISION
Filed: June 11, 2001 :
Attorney Docket No.: MERCK2272 :

This is in response to the petition under 37 CFR 1.181, filed June 10, 2004 requesting a withdrawal of the Restriction requirement of April 21, 2003.

BACKGROUND

A review of the file history shows that the application was accepted under 35 U.S.C. 111 on June 11, 2001. The application as filed contained claims 1-11. In the first office action mailed February 10, 2003 the examiner set forth a restriction requirement under 35 U.S.C. 121 dividing the claims into 3 groups and requiring an election of species within the first group if elected, as follows:

- Group I, Claims 1-7, drawn to an ionic liquid, classified in class 252, subclass 62.2.
- Group II, Claims 8, 10-11, drawn to an electrochemical cell and an electrolyte composition, classified in class 429, subclass 188.
- Group III. Claim 9, drawn to a capacitor, classified in class 361, subclass 503.

Applicants responded on March 6, 2003, electing Group I, with traverse, and electing a species as required. In the traversal, Applicants argued that the groups were not an intermediate/final product as the examiner had stated but a combination/subcombination that required a two-way distinction.

Upon the election of Group I the application was transferred from Art Unit 1754 to Art Unit 1626 where the ionic liquid structure is examined.

A first action on the merits was sent out on April 21, 2003. In this action, the examiner responded to applicant's traverse by stating that indeed the Groups were not related as intermediate/final products but as products and processes but retained the same three groups. The restriction was not made final at this time.

In a response by Applicants on July 21, 2003 to the first office action, Applicants again stated

that the groups were not related by a product and process of using but by a combination/subcombination and requested a removal of the restriction.

On December 17, 2003 the action was made final.

DISCUSSION

Upon review of the restriction requirement, it is noted that the three groups represent combination/subcombination relationships as stated by the Applicant.

There has been no two-way distinction shown. The subcombination is essential to the combination and there is no evidence that combination is patentable without the details of the subcombination. See MPEP 806.05(c).

In this instance the subcombination which is the ionic liquid constitutes the essential distinguishing feature of the combination as claimed (e.g. capacitor using said ionic liquid or the electrochemical cell using said ionic liquid) and therefore the inventions are not distinct and a requirement for restriction between the combination and subcombinations should not have been made, even though the subcombination has separate utility.

The petition is **GRANTED**.

It is noted that there are many core structures encompassed within Group I. The examiner may reevaluate the propriety of a restriction requirement among said structures.

The application will be forwarded to the examiner for further action.

Should there be any questions about this decision please contact Jean F. Vollano by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0648 or by facsimile sent to the general Office facsimile number.



Bruce M. Kisliuk
Director, Technology Center 1600